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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,642	08/01/2003	Joseph R. Habert	1966-152	2756
22440	7590	03/22/2005	EXAMINER	
GOTTLIEB RACKMAN & REISMAN PC 270 MADISON AVENUE 8TH FLOOR NEW YORK, NY 100160601			HOEY, ALISSA L	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/632,642

Applicant(s)

HABERT, JOSEPH R.

Examiner

Alissa L. Hoey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to after final remarks and exhibits received 02/18/05. The exhibits prove to overcome the final rejection based upon Cohen (US 2004/0187193) issued in office action of 11/17/04. The final office action of 11/17/04 has been withdrawn. Claims 1-19 and 21 have been finally rejected below.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added limitation in the claims of “..stuffing conforms to the shape of the object” was not disclosed in the originally filed specification, drawings or claims.

### ***Claim Rejections - 35 USC § 102***

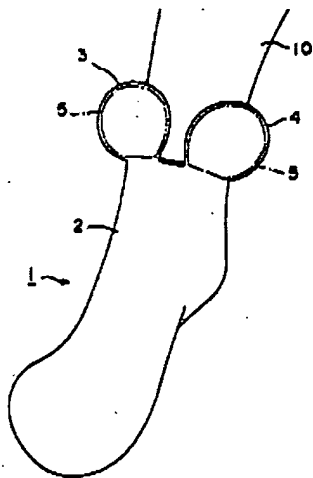
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 7, 11, 13 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirano (US 5,325,545).



(14) Furthermore, in addition to the formed ears as mentioned above, when a face of an animal is formed by drawing a pattern on the sock main body 2 with yarn of a different color, or by sewing a piece of cloth or button, or by forming protrudings and recesses at the time of knitting the sock main body 2, the interest will be further increased. Moreover, if a pattern representing a hole of the ear is drawn on the surface of each of the bags 3 and 4, the bags 3 and 4 will be more look like the ears.

In regard to claim 1, Hirano provides a three dimensional object attached to the sock near the foot opening and the object including a skin and stuffing (figure 9, identifiers 3-5: column 1, lines 27-37 and column 2, lines 37-62). The object having a three-dimensional shape when stuffed. Also provided on the sock of Hirano is indicia being related visually to the stuffed object (figure 9, identifier 5: column 3, lines 43-52). The indicia is in the form of an animal face and is formed by drawing a pattern on the sock with yarn of a different color, sewing a piece of cloth or button, or by forming protruding recesses during the knitting process (column 3, lines 43-52). The shape of the three dimensional object is primarily determined by the skin filled with the stuffing (figures 4-6). The stuffing is capable of conforming to the shape of the skin

depending upon the shape of the skin and the stuffing. Nothing in Hirano prevents the skin and stuffing from being the same shape.

In regard to claim 7, Hirano provides indicia that is two dimensional, since yarn being sewn to a pattern on the body of the sock is a two dimensional decorative indicia (column 3, lines 43-52).

In regard to claim 11, Hirano provides indicia comprising a visual illustration, since yarn in the form of a pattern is visual illustration (column 3, lines 43-52).

In regard to claim 13, Hirano provides the indicia comprises a design since, yarn being sewn to a pattern on the body of the sock in the form of an animal face is a design (column 3, lines 43-52).

In regard to claim 21, Hirano teaches a decorative sock (1) including a sock body (2) having a toe and a foot opening (figure 9). A three-dimensional object (3 and 4) having a three-dimensional shape when stuffed (column 1, lines 54-61). Attached to the sock near the foot opening, the object includes a preformed skin and an inherently deformable stuffing which is capable of conforming to the shape of the object (column 1, lines 54-61). The three-dimensional shape of the object being primarily determined by the skin filled with the stuffing (figure 4-6) and indicia on the sock body being related visually or texturally to the object (column 3, lines 43-52).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-6, 8-10, 12 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano.

Hirano provides a sock with stuffed object and indicia as described above in claims 1, 7 and 11. However, Hirano fails to teach the stuffed object being a miniaturized toy, an animal head, an animal, an electronic device or a cellular phone. Further, Hirano fails to teach the indicia comprising a word, a phrase, a number, a fictional character, indicia visually similar to the stuffed object, a drawing of the stuffed object, a word which is the common name of the stuffed object, a word that embodies an act performed during a use or creation of a version of the object or a phrase that is normally associated with the object.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the stuffed object being a miniaturized toy, an animal head, an animal, an electronic device or a cellular phone because Applicant has not disclosed that providing the stuffed object in the form of a miniaturized toy, an animal head, an animal, an electronic device or a cellular phone, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the stuffed object being in any form including animal ears because as long as there is a stuffed object on a sock to add to the aesthetic appeal of the sock it doesn't matter what form it takes. Therefore, it would

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have been an obvious matter of design choice to modify Hirano to obtain the invention as specified in claims 2-6.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the indicia comprising a word, a phrase, a number, a fictional character, indicia visually similar to the stuffed object, a drawing of the stuffed object, a word which is the common name of the stuffed object, a word that embodies an act performed during a use or creation of a version of the object or a phrase that is normally associated with the object because Applicant has not disclosed that providing the indicia in the form of a word, a phrase, a number, a fictional character, indicia visually similar to the stuffed object, a drawing of the stuffed object, a word which is the common name of the stuffed object, a word that embodies an act performed during a use or creation of a version of the object or a phrase that is normally associated with the object provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with indicia being in the form of an animal face because as long as the sock has indicia that in some way adds to the aesthetic appeal of the sock. Therefore, it would have been an obvious matter of design choice to modify Hirano to obtain the invention as specified in claims 8-10, 12 and 14-19.

#### ***Response to Arguments***

4. Applicant's arguments filed 10/13/04 have been fully considered but they are not persuasive. Applicant's remarks have been reviewed and discussed below.

Applicant argues that Hirano (US 5,325,545) fails to teach “the stuffing conforming to the shape of the three-dimensional object and that the shape is determined by the skin”.

Examiner notes that depending upon the type or shape of the stuffing used and the shape or type of skin determines if the skin or the stuffing shapes the object. The skin is disclosed in Applicant's specification as being capable of being made out of “...natural and synthetic materials such as cotton, polyester, acrylic, nylon and spandex”. Depending upon the type of skin used in combination with the amount and type of stuffing determines if the skin or stuffing takes shape of the object. For example spandex is resilient, stretch material and depending what it is stuffed with would determine the shape of the object.

The bag of Hirano is capable of determining the shape of the object especially if the stuffing is smaller than the bag or is exactly the same size as the bag. The bag of Hirano already has a determined shape and depending upon the stuffing the bag is capable of retaining it's original determined shape with just a thicker appearance.

Even though the specification does state that “the use of a skin, following well known techniques for making stuffed objects, enable the ornament to assume shapes that are more intricate and multifaceted”. It does not state that the stuffing conforms to the shape of the skin. It only details that the use of a skin assists with shapes that are more intricate and multifaceted. It is silent about the stuffing conforming to the skin.



Further, Applicant argues that Hirano fails to disclose the ability of complex shapes including a miniaturized toy, an animal head, an animal and an electronic device or a cellular phone.

Examiner notes that a miniaturized toy can be any shape of object including a ball it does not have to be intricate to be a miniaturized toy. An animal head can be a circular or oval shape which is not intricate to form. An animal can take the form of a slug which is just a round shape and therefore does not require it to be intricate. Finally, a cellular phone is in the shape of a rectangle which is not intricate to form. Applicant's arguments that the objects of the shape are intricate and therefore not capable of being formed by the device of Hirano is not convincing since the shape of the object does not need to be intricate to form the above discussed shapes.

Therefore, for the reasons stated above this action is made final.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

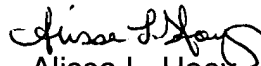
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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